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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,436	02/26/2004	William R. Patterson	355492-3150	5693

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EXAMINER	
ROGERS, JAMES WILLIAM	
ART UNIT	**PAPER NUMBER**
1618	

MAIL DATE	DELIVERY MODE
09/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/789,436	PATTERSON ET AL.	
	Examiner	Art Unit	
	James W. Rogers, Ph.D.	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-23 and 25-40* is/are pending in the application.

4a) Of the above claim(s) *23,25-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1,3-22 and 30-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendments to the claims and specification filed 08/27/2007 have been entered. Applicants have cancelled claims 2 and 24 and amended claims 1,4-5,10-11,19-22 and 25. Any rejection/objection from the previous office action not addressed below has been withdrawn.

Response to Arguments

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3-16,18-23, 30-36,38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Porter et al. (US 2004/0156781 A1).

Applicant's arguments filed 08/27/2007 have been fully considered but they are not persuasive.

Applicants assert that Porter does not define the combination of all of the essential parameters of the claimed invention i.e., the shear rate, the viscosity and the shear thinning index to achieve delivery of a high viscosity embolizing composition.

Applicants further state that Porter does not recite a shear thinning index of at least 5 and the viscosity achieved by a particular shear rate. As evidence applicants point to table 1 to show that the shear thinning index is only 2.15 and to figure 1 which shows a shear viscosity below the required viscosity of applicants claimed invention.

Applicants claimed invention is drawn to a composition, since the composition of Porter can comprise the same ingredients as applicants claimed invention within applicants claimed concentrations for those ingredients it is inherent that the same composition will have the same properties including its viscosity at a certain shear rate. Therefore since applicants claimed composition is essentially the same as the Porter reference any property claimed will be inherently met. It appears as though applicants are claiming a new property of a known composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case or either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Applicants arguments over the showing that the figure and table within Porter do not teach their claimed viscosities at a specific shear rate are also not persuasive. The examples within Porter were given solely for the purpose of illustration and were not to be construed as being limiting to their invention since many variations are possible without departing from the spirit and scope of the invention. Since Porter teachers compositions that can contain all of applicants claimed ingredients and the

same concentrations applicants claims rejected above are anticipated the Porter reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,3-22 and 30-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greff et al. (WO 00/71170 A1) in view of Porter (US 2003/0039696 A1).

Applicant's arguments filed 08/27/2007 have been fully considered but they are not persuasive.

Applicants assert as above that neither Porter nor Greff disclose the viscosities, shear rates or shear indices as claimed. Furthermore applicants state there is no

suggestion or motivation to a person of skill in the art to combine the references to achieve the claimed viscosities, shear rates and shear indices.

The relevance of these assertions is unclear. As in the remarks above since the combination of references discloses the same composition as applicants claimed invention the limitations for viscosities, shear rates and shear indices are inherently met. There does not have to be motivation to combine the references above to meet the above parameters because their combination will inherently meet applicants claimed viscosities, shear rates and shear indices.

Double Patenting

Applicants assert that they will address the obviousness provisional double patenting rejection over copending application # 10/789,946 once the office has allowed the pending claims.

Since no claims are allowable at this time the double patenting rejection still stands.

Conclusion

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 572-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER